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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/660,945

09/12/2003

Erik P. Staats

APPL-P2829COA

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28661

7590

10/20/2006

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EXAMINER

PAULA, CESAR B

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/660,945	Applicant(s) STAATS, ERIK P.	
	Examiner CESAR B. PAULA	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment filed on 8/8/2006.

This action is made Final.

2. In the amendment, claims 6-10 have been canceled. Claims 1-5, and 11-13 are pending in the case. Claims 1, and 11 are independent claims.

Priority

3. This application is a continuation of co-pending United States Patent Application Serial Number 09/429,233, filed October 28, 1999.

Information Disclosure Statement

4. The IDS filed on 6/14/2004 has been accepted, and considered by the Examiner.

Drawings

5. The drawings filed on 9/12/2003 have been accepted by the Examiner.

Specification

6. The disclosure is still objected to because of the following informalities: Please update the patent number of parent application 09/429,233 (parag. 0001).

Appropriate correction is required.

Double Patenting

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 11-13 remain rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 10, (11 and 13), and 12 of prior **U.S. Patent No. 6,691,096 B1, hereinafter 096**. This is a double patenting rejection.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-5, and 11-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 1, 9-10, (11 and 13), and 12 respectively of **U.S. Patent No. 6,691,096 B1, hereinafter 096** in view of Looney (Pat.# 6,232,539 B1, 5/15/2001, continuation filed on 6/17/1998).

Regarding claim 1, 096 teaches the limitations of these claims, except for *present the hierarchy to a device requesting data*. However, Looney discloses the display and organization of songs in a hard drive according to various categories. The categories further include subcategories, that in turn display various descriptive of the media data such as title, artist, date, etc. The categories and subcategories are displayed simultaneously on a gui (col.2, lines 30-67, col. 9, line 48-col.10, line 67, fig. 12-17)-- *present or display the hierarchy to a-- display-- device requesting data*. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine 096, and Looney, because of all the reasons found in Looney, including fully customizing music playback according to various parameters (col.1, lines 30-67), which would grant the user a more fulfilling and enjoyable listening experience.

This is a double patenting rejection.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter. Claims 1-5, and 11-13 are rejected under 35 U.S.C. 101 because claims 1, and 11 are directed toward a computer program product not embedded in a computer-readable medium. The product is non-functional descriptive material. See MPEP 2105(a).

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-5, and 11-13 remain rejected under 35 U.S.C. 102(e) as being anticipated by Looney et al, hereinafter Looney (Pat.# 6,232,539 B1, 5/15/2001, continuation filed on 6/17/1998).

Regarding independent claim 1, Looney discloses the display and organization of songs in a hard drive according to various categories. The categories further include subcategories, that in turn display various descriptive of the media data such as title, artist, date, etc. The categories and subcategories are displayed simultaneously on a gui (col.2, lines 30-67, col. 9, line 48- col.10, line 67, fig. 12-17)-- *compile a plurality of containers containing AV/C descriptor data;*

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register one or more fields within each said container, and arrange said containers into a logical hierarchy; present or display the hierarchy to a-- display-- device requesting data.

Regarding claim 2, which depends on claim 1, Looney discloses the songs are stored within the subcategories as mpeg3 files, having category flags appended to them. The files, which are listed in various order, are played back to a user (col.2, lines 30-67, fig. 12-17)-- *associating addresses with each of said fields sequentially enumerated within each of said containers.*

Regarding claim 3, which depends on claim 2, Looney discloses that the files are listed in various orders, such as ascending, descending, etc (col.2, lines 30-67, col. 9, lines 1-67, col.10, lines 30-67, fig. 12-17)-- *mapping said fields to a prescribed field list.*

Regarding claim 4, which depends on claim 3, Looney discloses the display of various categories, such as title, artist, date, etc., which are listed individually from other categories (col.2, lines 30-67, col.9, lines 48-col.10, line 67, fig. 12-17)-- *accessing any field within any container independently of any other container, and reading data from any field within any container without affecting the access to any other container--* (col.2, lines 30-67, col. 9, line 48-col.10, line 67, fig. 12-17).

Regarding claim 5, which depends on claim 4, Looney discloses the display of various categories, such as title, artist, date, etc., which are listed individually from other categories

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(col.2, lines 30-67, col.9, lines 48-col.10, line 67, fig. 12-17)-- *said plurality of containers comprise in combination an AV/C general object list descriptor.* (col.2, lines 30-67, col. 9, line 48-col.10, line 67, fig. 12-17).

Regarding independent claim 11, Looney discloses the organization of songs in a hard drive according to various categories. The categories further include subcategories. The categories and subcategories are displayed simultaneously on a gui. The categories are displayed in a list according to a certain order, and category as result of a search of the songs in the containers. The song is played by the queuing of the song and setting a timer to 0. The user can then indicate the length of playtime of a song selected to be played (col.2, lines 30-67, col.9, line 1-col.10, col. 14, lines 37-50, col.10,lines 30-67, fig. 12-17, 27). In other words, a category listing is replaced with a newly selected category list as indicated by a user-- *identify a top level data container containing AV/C descriptor data; initialize compilation attributes; sequentially read the container data; and copy said read data into a readable buffer.*

Regarding claim 12, which depends on claim 11, Looney discloses the queuing of a song to be played and setting a timer to 0. The user can then indicate the length of play time of a song selected to be played (col.2, lines 30-67, col.9, lines 33-47, col. 14, lines 37-50, col.10,lines 30-67, fig. 27)-- *establishing a read buffer in a memory space and setting the read buffer offset to zero; establishing a received address request as a starting address, establishing a received read length request as a length sought.*

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Regarding claim 13, which depends on claim 12, Looney discloses searching, and displaying songs in the categories, and subcategories (col.2, lines 30-67, col.8, lines 58-col.9, line 47, fig. 12)-- *the sequentially reading container data activity includes recursively searching for responsive data, said search initialized with said initialized attributes.*

Response to Arguments

14. Applicant's arguments filed on 8/8/2006 have been fully considered but they are not persuasive. The Applicant indicates that Looney does not teach the hierarchical containers containing AV/C descriptor (page 4). The Examiner disagrees, because Looney discloses the display and organization of songs in a hard drive according to various categories. The categories further include subcategories, that in turn display various descriptive of the media data such as title, artist, date, etc.- *AV/C descriptor data*. The categories and subcategories--*hierarchy*--are displayed simultaneously on a gui (col.2, lines 30-67, col. 9, line 48-col.10, line 67, fig. 12-17)

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The Examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:
Commissioner for Patents
P.O. Box 1450

Alexandria, VA 22313-1450

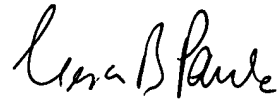
Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)

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A handwritten signature in black ink, appearing to read "Cesar Paula".

10/13/06

CESAR PAULA
PRIMARY EXAMINER